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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,111	01/21/2004	William J. Wechter	3829.03-1	5923

7590 08/03/2006

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EXAMINER

ZHANG, NANCY L

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,111

Applicant(s)

WECHTER ET AL.

Examiner

Nancy L. Zhang

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1614

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

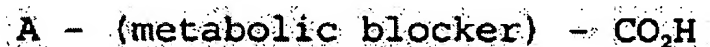
- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

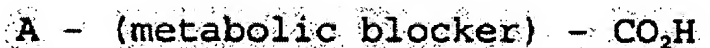
Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 25-48, drawn to products comprising a compound of the formula



, classified in class 424, subclass 439. If this group is elected, the below summarized species election is also required.

- II. Claims 1-24, drawn to methods of using the product comprising a compound of the formula



to substitute a food composition comprising an edible fat, classified in class 424, subclass 439. If this group is elected, the below summarized species election is also required.

The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and Group II are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using that product

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because a product comprising a compound of the above formula such as an ester of a polyhydric alcohol can be a papermaking composition.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

### ***Species Election for Group I***

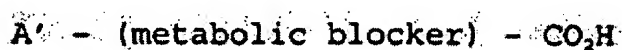
Invention in Group I contains claims directed to the following patentably distinct species:

A product comprising a compound where the compound is:

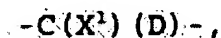
(I-a) an ester of triglyceride

(I-b) an ester of a polyhydric alcohol that is not (I-a); the applicant is required to specify a compound.

(I-c) a compound that is not (I-a) – (I-b) but is of formula



as defined in claim 25 where the metabolic blocker is:



as defined in claim 26. The applicant is required to specify a specific A', X<sup>1</sup> and D in the formula.

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(I-d) a compound that is not (I-a) – (I-c) but is of formula



as defined in claim 25 where the metabolic blocker is:



as defined in claim 34. The applicant is required to specify a specific A', Y, V, and m in the formula.

(I-e) a compound that is not (I-a) – (I-c) but is of formula



as defined in claim 25 where the metabolic blocker is:

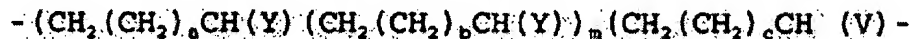


as defined in claim 35. The applicant is required to specify a specific A', Y, V and m in the formula.

(I-f) a compound that is not (I-a) – (I-e) but is of formula



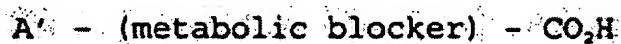
as defined in claim 25 where the metabolic blocker is:



as defined in claim 33. The applicant is required to specify a specific A', Y, V, a, b, c and m in the formula.

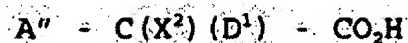
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(I-g) a compound that is not (I-a) – (I-f) but is of formula



as defined in claim 25. The applicant is required to specify a compound.

(I-h) a compound that is not (I-a) – (I-g) but is of formula



as defined in claim 37. The applicant is required to specify a specific A'', X<sup>2</sup> and D<sup>1</sup> in the formula.

### ***Species Election for Group II***

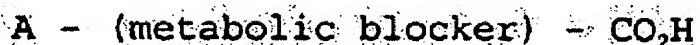
Invention in Group II contains claims directed to the following patentably distinct species:

A product comprising a compound where the compound is:

(II-a) an ester of triglyceride

(II-b) an ester of a polyhydric alcohol that is not (II-a); the applicant is required to specify a compound.

(II-c) a compound that is not (II-a) – (II-b) but is of formula



as defined in claim 5 where the metabolic blocker is:

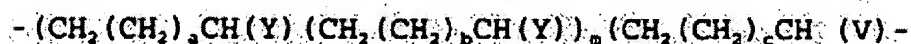


as defined in claim 6. The applicant is required to specify a specific A, X and D in the formula.

(II-d) a compound that is not (II-a) – (II-c) but is of formula

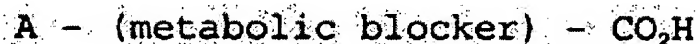


as defined in claim 5 where the metabolic blocker is:

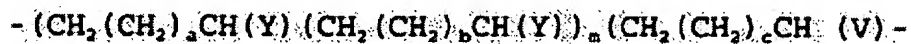


as defined in claim 9 and V is methyl and Y is methyl. The applicant is required to specify a specific m, a, b, and c in the formula.

(II-e) a compound that is not (II-a) – (II-d) but is of formula

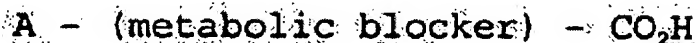


as defined in claim 5 where the metabolic blocker is:



as defined in claim 9. The applicant is required to specify a specific V, Y, m, a, b, and c in the formula.

(II-f) a compound that is not (II-a) – (II-e) but is of formula



as defined in claim 5. The applicant is required to specify a compound.

The above species are independent or distinct because the compounds used in the products are different. Different compounds have different structures, chemistry and biological effects. As an ingredient of a food product, compounds of the above listed species have different yield energy from beta-oxidation rendering metabolically different calories.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.  
MPEP § 809.02(a).



Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Notice of Possible Rejoinder***

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy L. Zhang whose telephone number is (571)-272-8270. The examiner can normally be reached on Mon.- Fri. 8:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*NLM* 8/1/2006  
NLZ

*Ardin H. Marschel* 8/1/06  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER